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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/120,105 09/10/93 WINTER

A HOE92F294

EXAMINER

IM22/0821

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ART UNIT

PAPER NUMBER

1713

DATE MAILED:

08/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SUPPLEMENTAL
Office Action Summary

Application No.
08/120,105

Applicant(s)

Winter et al.

Examiner

D.R. Wilson

Group Art Unit
1713



☒ Responsive to communication(s) filed on Feb 22, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 15 and 17-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 15 and 17-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

SUPPLEMENTAL DETAILED ACTION**1. Response to Amendments**

Applicant's amendment filed February 22 and 28, 2000 have just come before the Examiner along with the requests for issuance of a new Office Action. Applicant is correct in assuming that these two amendments had not been considered by the Examiner in issuing the Office Action of April 3, 2000, Paper No. 19. Therefore this Office Action supplements said earlier Action based upon the amendments, and the time for response is reset. The Office regrets the inconvenience to applicant due to mishandling of the amendments.

The above amendments have been fully considered with the following results.

a. The amendment of February 28, 2000 could not be entered because the amendment was submitted as a "paste-up" rather than as an original document. However, in order to advance prosecution of the application the Examiner will assume that applicant will submit an appropriate amendment in original form. Otherwise applicant should consider the amendment of February 22, 2000 to be objected to as containing new matter and Claim 17 to be not enabled under 35 U.S.C. 112, first paragraph, due to the erroneous formulas and placement thereof.

b. The objections and rejections set forth in Paper No. 19 are maintained except as modified and specifically noted below.

c. The rejection set forth in Detailed Action § 5(a) of Paper No. 19 is modified to read:

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Claims 15 and 17-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

d. The rejection set forth in Detailed Action § 5(b) of Paper No. 19 is modified to read:

Claims 15 and 17-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

e. The rejection set forth in Detailed Action § 5(c) of Paper No. 19 is modified to read:

Claims 17-20, 23-26 and 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for processes using racemates of chiral metallocenes as catalysts, does not reasonably provide enablement for processes using any and all metallocene catalysts.

f. The rejection set forth in Detailed Action § 5(d) of Paper No. 19 is modified to read:

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Claims 15, 17-20 and 24-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for processes using those metallocenes exemplified in the specification, does not reasonably provide enablement for use of combinations of any and all metallocenes.

g. The rejection set forth in Detailed Action § 6 of Paper No. 19 is modified to read:

Claims 15 and 17-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Further, § 6(a)(vii), 6(d) and 6(e) are modified to read as follows;

§6(a)(vii) There are two conflicting definitions of "n", i.e., it is used in both formulas I, II and III. Applicant needs to use a different symbol when the definitions are the same.

§ (6)(d) Claim 24 is indefinite because it is not known what the definitions are of R¹¹ and R¹², when they are connected to form a ring.

§ 6(e) Claim 25 is indefinite because of the word "may", as it is unclear whether the ligands carry additional substituents or not. However, the Office does accept the term "optionally", and it is suggested that "optionally" be substituted for "may". Further, the claim is indefinite because "additional substituents for R¹¹" are not defined in Claim 17.

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h. The rejection set forth in Detailed Action § 9 of Paper No. 19 is modified to read:

Claims 15 and 17-28 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP'734.

EP'734 clearly teaches the substituents of new Claim 28 (e.g., page 4, lines 20-25).

The Examiner also notes that on page 9 of the Office Action, EP'074 should obviously read EP'734.

i. The rejection as set forth in Detailed Action § 10 of Paper No. 19 is modified to read:

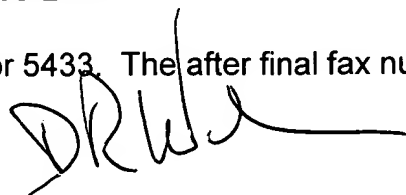
Claims 17-20, 24-26 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over (i) EP'046, or (ii) EP'046 and WO'414, both optionally further taken with EP'189 and Kaminsky.

EP'046 clearly teaches the substituents of new Claim 28 as well as teaching the metallocenes are chiral (e.g., Claims 1 and 5). The Examiner acknowledges that WO'414 doesn't by itself teach metallocenes as set forth in Formula I of Claim 17.

2. Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D.R. Wilson whose telephone number is (703) 308-2398. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, may be reached at (703) 308-2450.

The fax phone number is (703) 305-5408 or 5433. The after final fax number is (703) 305-3599.



D.R. WILSON
PRIMARY PATENT EXAMINER